The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 94

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID E. CHARLTON and NEIL W. MILLER,

Junior Party,
(Patent 5,714,389)

v.

ROBERT W. ROSENSTEIN,

Senior Party,
(Application 09/167,028).

Patent Interference 104,476

Before: McKELVEY, Senior Administrative Patent Judge, and GARDNER-LANE and TIERNEY, Administrative Patent Judges.

GARDNER-LANE, Administrative Patent Judge.

FINAL DECISION

A. Conference call

A telephone conference call was held on 23 March 2001, between approximately 10:00 a.m. and 10:40 a.m., involving:

(1) Edmund R. Pitcher, Esq., counsel for Charlton;

(2) Jeffrey H. Ingerman, Esq., counsel for Rosenstein; and

(3) Fred E. McKelvey, Senior Administrative Patent Judge and Sally Gardner-Lane and Michael P. Tierney, Administrative Patent Judges.

(3) Fred E. McKelvey, Senior Administrative Patent Judge and Sally Gardner-Lane and Michael P. Tierney, Administrative Patent Judges.

B. Discussion

One purpose of the conference call was to discuss the disposition of both this interference and companion Interference 104,148. A final order has been entered in Interference 104,148 (see Paper 153 in that interference, entered 2 April 2001). Another purpose of the conference call was to reach a consensus on a final order that preserves the right of the parties to seek judicial review on certain issues.

1. Status of this interference

The interference was declared 19 November 1999 (Paper 1, page 1) with Count 1 (Paper 1, page 47):

Count 1

A method according to any of claims 5 or 10 of Charlton patent 5,714,389,

or

a method according to claim 74 of Rosenstein application 09/167,028.

The status of the claims of the parties, at the time the interference was declared, is as follows:

The claims of the parties were:

Charlton:	1-10
Rosenstein:	1-74

The claims of the parties which were designated as corresponding to Count 1, and therefore were involved in the interference (35 U.S.C. § 135(a)), were:

Charlton:	5 and 10
Rosenstein:	74

The claims of the parties which were designated as not corresponding to Count 1, and therefore were not involved in the interference (35 U.S.C. § 135(a)), were:

Charlton:	1-4 and 6-9
Rosenstein:	1-73[1]

At the time this interference was declared, Interference 104,148 was in the preliminary motion stage. After this interference was declared, an order was entered in Interference 104,148 holding that Rosenstein claim 74 was not patentable to Rosenstein (see Interference 104,148, Paper 127 at page 104). Specifically, a motions panel determined that Rosenstein claim 74 failed to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112.

During the preliminary motion phase of this interference, Rosenstein timely moved to add Rosenstein claim 75 to its involved reissue application, essentially for the purpose of having an interference between Rosenstein claim 75 and Charlton claims 5 and 10. Rosenstein's attempt to have Rosenstein claim 75 added to its reissue application was entirely consistent with

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[1] Rosenstein claims 1-73 have been held to be unpatentable to Rosenstein in Interference 104,148, inter alia, because Charlton prevailed on the issue of priority.

the philosophy of 37 CFR § 1.633(i), which permits a party inter alia to file a preliminary motion to amend or add claims to its involved application as part of its response to a preliminary motion (37 CFR § 1.633(a)) by an opponent attacking the patentability of claims already in the interference. The attack on the patentability of Rosenstein reissue claim 74 arose as a result of an opposition filed in Interference 104,148. Under the circumstances, the board felt it appropriate to give Rosenstein an opportunity to attempt to substitute a claim (which turns out to be Rosenstein reissue claim 75) for Rosenstein claim 74 which was held for the first time to be unpatentable after this interference was declared.

An amendment submitted by Rosenstein in its involved reissue application requesting that Rosenstein claim 75 be added to the application will be entered. 37 CFR § 1.615(a), second sentence. Accordingly, Rosenstein claim 75 is deemed to be a claim in the involved Rosenstein reissue application.

2. Rosenstein reissue claim 74

Rosenstein reissue claim 74 is "involved" in this interference within the meaning of 35 U.S.C. § 135(a). In view of the declaration of this interference, facially there is an interference-in-fact between the subject matter of Rosenstein reissue claim 74 and the subject matter of Charlton claims 5 and 10. During the conference call, Rosenstein expressed a concern that Rosenstein might not have an opportunity to seek, if it be so advised, judicial review of the board's holding of

unpatentability with respect to Rosenstein reissue claim 74. Counsel's concern is legitimate, given that Rosenstein claim 74 was never "involved" in Interference 104,148 (i.e., it was never designated as corresponding to a count) and yet the evidence and arguments relevant to its patentability appear in the file of Interference 104,148.

Charlton timely challenged the patentability of Rosenstein reissue claim 74 in Interference 104,148. Rosenstein timely opposed the challenge, again in Interference 104,148. The issue of whether Rosenstein reissue claim 74 failed to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112 was fully briefed and considered in Interference 104,148. In order to enter a final order[2] in Interference 104,148, the parties were advised that the issue of the patentability of Rosenstein reissue claim 74 would be "transferred" to this interference where claim 74 is manifestly "involved" having been designated as corresponding to a count in this interference. It is the board's understanding that the parties consented to the transfer. Accordingly, upon entry of a final order in this interference, it is the board's view that Rosenstein has preserved its option to seek judicial review

[2] The board understands that the final order in Interference 104,148 will not be subject to judicial review because it was entered as a result of an agreement to arbitrate and part of the agreement contemplates no judicial review.

(35 U.S.C. § 141 or 146) of our holding of unpatentability of Rosenstein claim 74.[3]

3. No interference-in-fact between Rosenstein reissue claim 75 and Charlton claims 5 and 10

During the conference call, counsel were advised that it is the position of the board that Rosenstein had failed to establish that there is an interference-in-fact between (1) the subject matter of Rosenstein reissue claim 75 and (2) the subject matter of Charlton claim 5 or 10. A MEMORANDUM OPINION AND ORDER explaining the board's position, based on arguments and evidence filed by the parties, accompanies this FINAL DECISION.

It is the board's understanding that neither party intends to seek judicial review of the holding of no interference-in-fact.

4. Patentability of Rosenstein reissue claim 75 and Charlton claims 5 and 10

In response to Rosenstein's attempt to add Rosenstein reissue claim 75 to this interference, Charlton challenged the patentability of claim 75. The board has not resolved Charlton's challenge. It is the board's understanding that if there is judicial review, Charlton does not intend to raise the patentability of Rosenstein reissue claim 75.

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[3] If as a result of judicial review Rosenstein claim 74 is held to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112, a remand would be necessary to consider other issues relating to claim 74 and possibly priority.

Rosenstein filed a preliminary motion seeking entry of judgment (37 CFR § 1.633(a)) as to Charlton claims 5 and 10 on the ground that those claims are unpatentable over the prior art. During the conference call, counsel for Rosenstein indicated that Rosenstein probably would not raise in any judicial review an issue with respect to the patentability of Charlton claims 5 and 10.

In light of the above, the board will exercise its discretion to conserve resources and will not further consider the patentability of Rosenstein reissue claim 75 or Charlton claims 5 and 10.

5. Judicial review

Based on the discussion during the conference call, the board came to the conclusion that the only issue which might be subject to judicial review is our holding that Rosenstein reissue claim 74 does not comply with the written description requirement of the first paragraph of 35 U.S.C. § 112. Our rationale in support of our holding appears in papers in Interference 104,148, and we see no reason to repeat that rationale here.

We believe we have reached a just, speedy and hopefully inexpensive (37 CFR § 1.601) disposition in this interference, aided considerably by the availability and willingness of counsel to discuss the matter in a conference call. We express our appreciation to counsel for their respective efforts in this regard. Further, we wish to make clear that it is not our intention to avoid resolution of issues which a party fairly

raised and wants decided. Nor is it our intention to engage in resolving an issue which the parties do not believe needs to be resolved notwithstanding it having been developed on the record. Accordingly, if a party believes that the board misapprehended the discussion during the conference call, or overlooked a point discussed during the conference call, or that additional work needs to be done by the board, we urge the party to file a request for reconsideration (37 CFR § 1.658(b)). Should either party timely file a request for reconsideration, this FINAL DECISION should no longer be considered final for the purpose of judicial review, pending resolution of any request for reconsideration.

C. Order

Upon consideration of the record, including that part of Interference 104,148 related to the unpatentability of Rosenstein reissue claim 74 for failure to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112, and for the reasons given, it is

ORDERED that Rosenstein claim 74 is not patentable to Rosenstein. 35 U.S.C. § 112, first paragraph (written description).

FURTHER ORDERED that Rosenstein is not entitled to a reissue patent containing claim 74 of Rosenstein reissue application 09/167,028.

FURTHER ORDERED that the amendment presenting Rosenstein reissue claim 75 is entered in the file of Rosenstein reissue application 09/167,028. 37 CFR § 1.615(a).

FURTHER ORDERED that there is no interference-in-fact between (1) the subject matter of Rosenstein reissue claim 75 and (2) the subject matter of Charlton claims 5 or 10.

FURTHER ORDERED that any request for reconsideration must be filed within **one (1) month** of the date of this FINAL DECISION. 37 CFR § 1.658(b)).

FURTHER ORDERED that if either party timely files a request for reconsideration, this FINAL DECISION shall no longer be deemed final for the purpose of judicial review pending entry of a decision on any request for reconsideration.

FURTHER ORDERED that if there is a settlement agreement which has not already been filed in the Patent and Trademark Office, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

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Administrative Patent Judge)
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SALLY GARDNER-LANE) BOARD OF PATENT
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104,476
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